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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/100,129	06/19/1998	PAUL HAVERSTOCK	23452-034	8225

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EXAMINER

KANG, PAUL H

ART UNIT PAPER NUMBER

2141

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/100,129

Applicant(s)

HAVERSTOCK ET AL.

Examiner

Paul H Kang

Art Unit

2141

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: the arguments are not deemed to be persuasive.

DOUBLE PATENTING REJECTION

The applicant failed to address the double patenting rejection of the previous Office action stating "Applicants will consider filing a terminal disclaimer statement once otherwise patentable subject matter has been identified." This is improper. Applicant is reminded that a proper response to an Office action must address all rejections set forth therein. See 37 CFR 1.111. Any future responses failing to address all issues in the prior Office action will be held nonresponsive.

REJECTIONS UNDER 35 USC 103

Applicants argue the rejection of claims 1-4, 6-11, 13-19, 21-24 and 26-33 under 35 U.S.C. 103(a) as being unpatentable over Flores, US Pat. No. 6,073,109 in view of Leone, US Pat. No. 5,745,360 improper because A) Flores and Leone, either alone or in combination, fail to teach or suggest all elements of the claimed invention; B) There is no legally proper suggestion or motivation to combine Flores and Leone; and C) the examiner's motivation constitutes impermissible hindsight.

Applicant argues that "[a]t best, Flores describes notifying a user of steps to be completed and managing reminders to the user to keep the process of completing the task moving." This is an inaccurate and incomplete description of the Flores teaching. As previously set forth in the Office action, Flores teaches the claimed invention substantially as claimed. Flores teaches a workflow system for managing workflow by enabling execution of actions required by users.

Flores, however, fails to explicitly teach "a markup language translator that translates the one or more non-markup language objects to representations of one or more markup language objects" for the purpose of enabling said at least one user to execute said at least one action notified by the workflow module.

It is unnecessary that Leone teach or suggest "enabling a user to execute workflow action required for a translated non-markup language object using the browser in response to translating the non-markup language object to a markup language object," as suggested by the applicant. Leone must not be viewed alone but in light of Flores. Requiring Leone, as suggested by applicant, to teach "enabling a user to execute workflow action..." is incorrect.

Leone was relied upon to show prior teachings of a dynamic hypertext link converter system wherein non-hypertext documents are translated into hypertext documents in order to provide access to legacy databases (See Leone, col. 1, line 5 - col. 2, line 19). Flores substantially teaches the claimed invention but is silent as to hypertext conversion. Flores teaches enabling a user to execute workflow action.

The Flores teaching was designed to have interoperability among different applications and across diverse platforms; i.e. including non-markup language Lotus Notes and other communication platforms. See Flores, col. 1, lines 52-58. The artisan of ordinary skill in the art at the time the invention was made would have been motivated to incorporate a system and method to convert non-hypertext document to HTML based documents, as taught by Leone, into the workflow system of Flores for the purpose of allowing interoperability among different applications and across diverse platforms.



PAUL H. KANG
PRIMARY PATENT EXAMINER